UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,244	12/08/2003	Stephen C. Tulley	00-019-C1	2482

22927 7590 12/03/2004

WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER	
BROCKETTI, JULIE K	
ART UNIT	**PAPER NUMBER**
3713	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/730,244	TULLEY ET AL.	
	Examiner	Art Unit	
	Julie K Brocketti	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 September 2004*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 27, 2004 has been entered.

Priority

Applicant is required to update the first paragraph of the specification in regards to the status of priority applications.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or

patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 45-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10, 12 and 33 of U.S. Patent No. 6,688,976. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim methods for facilitating a lottery ticket transaction involving receiving requests to purchase a lottery ticket, receiving an indication that the lottery number combination is to be associated with only a limited number of occurrences for the drawing and determining a price associated with the ticket based on the received indication and agreement that not more than the limited number of occurrences of the lottery number combination will be sold.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 48 is rejected under 35 U.S.C. 102(b) as being anticipated by "New National Phone Service Helps Lotto Players Increase Their Chances

of Winning". "New National Phone Service Helps Lotto Players Increase Their Chances of Winning" discloses a method of facilitating a lottery ticket transaction. The lottery ticket is associated with a lottery number combination. The lottery system receives a request from a player to purchase the lottery ticket for a lottery drawing (See Scanlon Fig. 2). Player's requesting lottery number combinations that are exclusively associated with only a single lottery ticket for the lottery drawing. The lottery number combinations are determined such that a lottery number combination is associated with only a single lottery ticket. Therefore, the lottery number combination is prevented from being associated with at least one additional lottery ticket (See "New National Phone Service Helps Lotto Players Increase Their Chances of Winning").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 36-40 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scanlon, U.S. Patent No. 4,922,522 in view of "Double Lotto". Scanlon discloses a method of facilitating lottery ticket transactions.

The lottery system receives a request from a player to purchase a lottery ticket for a pari-mutuel lottery game. The player sends his selected lottery number combination for a lottery drawing to the lottery agent (col. 2 lines 57-63). The price of the lottery ticket having a lottery number combination is determined. (Fig. 2; col. 5 lines 18-33) [claim 36].

Scanlon lacks in disclosing determining the price of a ticket based on an expected value associated with the lottery ticket having the lottery number combination. The Washington State Lottery introduced a game entitled "Double Lotto." The lottery agent receives a request from a player to purchase a lottery ticket for a pari-mutuel lottery game. Players can pay $2 for a ticket instead of the regular $1 per ticket price. By paying the extra dollar players automatically double the prize amount if they win. Consequently, the price of the ticket is determined based on the expected value associated with the lottery ticket, i.e. the price of the ticket is doubled based on doubling the expected value of doubling the jackpot [claim 36]. Furthermore, the player makes the double bet for the specific lottery ticket with a specific lottery number combination. It is also based on a current winning amount, i.e. double the price for double the jackpot (See "Double Lotto", pg. 1) [claim 38]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow players to receive the total jackpot amount even if multiple lottery tickets are winners [claim 37]. By paying an additional fee in Double Lotto players can ensure that their prize amount will be double the jackpot

value. Consequently, it would also be obvious to play an additional fee to ensure that you will win the entire jackpot amount even if there are multiple winners. As seen in Double Lotto, players want to win as much as possible and will pay additional fees in order to win more money. When players purchase tickets they are ensured of winning a current total winning amount even if the total winning amount is subsequently adjusted [claim 39]. For example, if a player purchases a ticket when the jackpot is $4 million, and the jackpot later rises to $8 million dollars, the player was still assured of winning $4 million at the time he purchased the ticket. In the game Double Lotto, the price of the ticket is independent of the cost of the lottery ticket to a lottery game provider; the cost of the ticket is based on how much of the jackpot a player wishes to win [claim 40]. Double Lotto as in any lottery game determines the price of a ticket based on a minimum price that subsequent players will be required to provide in exchange for participating in the pari-mutuel lottery game [claim 43]. For example, all regular tickets cost $1, which is the minimum price a player, must play to enter the game. Another price is determined that subsequent players will be required to provide in exchange for another lottery ticket having at least an expected value [claim 44]. For example, tickets cost $2 to have an expected value of twice the jackpot. It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the "Double Lotto" system into the lottery game of Scanlon. Players want to win as much money as possible. By only

paying one extra dollar, players can expect to win twice the jackpot amount. Consequently, this is an incentive to both the player and the lottery agent. The player can win more money and the lottery agent is able to collect more money in ticket sales.

Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scanlon in view of "Double Lotto" in further view of "Our Opinion State Scamming lottery buyers". Scanlon, lacks in disclosing determining the potential price amount based on a current popularity of a lottery number combination. "Our Opinion State Scamming lottery buyers" teaches of locking out particular numerical combinations that are too popular (See "Our Opinion State Scamming lottery buyers") [claims 41 & 42]. By not allowing players to purchase tickets with popular combinations, the lottery agents are able to maintain their interest in the game. By controlling the odds, the lottery agents can ensure that they receive a portion of the bets, in turn determining a potential prize amount. It would also have been obvious to one of ordinary skill in the art at the time the invention was made to determine a ticket price based on the past popularity of a lottery number combination. If a lottery number combination is very popular the lottery agent can adjust the price of the ticket either higher or lower than normal to ensure that the lottery agent receives their share of the bets made thus maintaining their interest in the game. This is good business practice.

Allowable Subject Matter

Claims 45-47 would be allowable if rewritten or amended to overcome the double patenting rejection, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: Scanlon discloses informing the player of how many occurrences a particular lottery combination has so far in the lottery drawing. However, none of the prior art determines a price associated with a lottery ticket based on an indication that only a lottery number combination will be associated with a limited number of occurrences for the lottery drawing and an agreement that not more than the limited number of occurrences of the lottery number combination will be sold for the lottery drawing.

Response to Amendment

It has been noted that claims 36, 41, and 42 have been amended. New claims 45-48 have been added.

Response to Arguments

Applicant's arguments filed September 27, 2004 have been fully considered but they are not persuasive.

Applicant argues that Double Lotto does not suggest that a price of a ticket is determined based on the expected value of a ticket with a certain

lottery number combination. The Examiner disagrees and notes that the ticket price is determined based on how much of a prize the player expects to win for that specific lottery ticket with that specific lottery number combination. For example, a player purchases a ticket with a specific number combination and the player pays $1 for the regular jackpot or $2 for the expected value of double the jackpot if the lottery number combination on his ticket matches the winning numbers.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that when many people select a particular lottery number combination, the expected value of that lottery number combination is lower when compared with a lottery number combination selected by only one person) are not recited in the rejected claim(s), specifically claim 36. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Terminal Disclaimer

The terminal disclaimer filed on October 12, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,688,976 has been reviewed and is NOT accepted.

It does not include a recitation that any patent granted shall be enforceable only for and during such period that said patent is commonly owned with the application(s) or patent(s) which formed the basis for the double patenting rejection. See 37 CFR 1.321(c)(3).

The last two sentences of the example of a terminal disclaimer seen below, must be included.

shortened by any terminal disclaimer, of prior Patent No. _____. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brocketti whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Julie K Brocketti
Examiner
Art Unit 3713